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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,900	10/04/2005	Takahashi Yasuo	TAKA3018	6283
23364 7590 05/19/2008 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314				
EXAMINER				
KOPEC, MARK T				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
05/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,900

Applicant(s)

YASUO ET AL.

Examiner

Mark Kopec

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/309)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

This application is a 371 of PCT/JP04/06406 (filed 05/06/04). The preliminary amendment filed 10/04/05 is entered. Claims 1-13 are currently pending.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in

order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wu et al (Epitaxial Layers and Bilayers...) or Thiele et al (Grain boundaries in YBa₂Vu₃O₇ films...).

Wu discloses (Abstract):

Cerium oxide (CeO₂), samarium-doped CeO₂ (Sm-CeO₂) and yttria-stabilized zirconia (YSZ) films and their bilayer heterostructures were grown on roll-textured Ni foil substrates by pulsed laser deposition (PLD). CeO₂ and CeO₂/YSZ films were also processed by photo-assisted metal-organic chemical vapor deposition (PhAMOCVD) for thick and large size film fabrication. The deposition conditions were optimized by changing deposition T and ambient gas pressure. The crystalline quality of YSZ, SmxCe_{1-x}O₂ films and their bilayers depends on the crystalline quality of the Ni substrate, and the quality of dielectric film - Ni interface. The oxide films are highly oriented as determined by θ -2 θ x-ray diffraction and x-ray pole-figure scans.

The reference specifically or inherently meets each of the claimed limitations.

Thiele discloses bicrystalline YBCO/Ce_{0.9}Gd_{0.1}O_{1.95} films grown on buffered metallic substrates (Abstract; page 204-205 section 2).

The references are anticipatory.

In the event that any minor modifications are necessary to meet the claimed limitations, such as selection of a particular

dopant atomic%, such modifications are well within the purview of the skilled artisan.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Belouet (6,649,570). or Chen et al (2004/0157747).

Belouet discloses buffer layer structure based on doped ceria for providing optimized lattice match with a YBCO layer in a conductor, a lattice matching layer for use in said structure and process of manufacturing thereof. Said buffer layer comprises a CeO₂ layer doped with a dopant, and has a superconductive layer of YBCO on said CeO₂ layer. The invention is characterized in that the CeO₂ layer is a lattice matching layer (Abstract). The reference specifies La, Eu and Nd dopants (Col 3, lines 1-18), and Ni alloy metallic substrate (Col 3, lines 40-50). The reference specifically or inherently meets each of the claimed limitations.

The reference is anticipatory.

In the event that any minor modifications are necessary to meet the claimed limitations, such as selection of a particular dopant atomic%, such modifications are well within the purview of the skilled artisan.

Claims 1-13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chen et al (2004/0157747).

Chen discloses thick atomically ordered single buffer layer for use in the integration of high temperature superconductor films with metallic substrates is disclosed. The buffer layer is a doped cerium oxide (CeO.sub.2) material, where the doping reduces layer cracking through the modification of thermal expansion coefficient and film strain properties, while adjusting chemical properties and lattice parameters to better match those of the substrate and HTS layer (Abstract). The reference also provides a method for making an apparatus of this invention including depositing a doped CeO.sub.2 based oxide, biaxially textured, buffer layer on a metallic substrate followed by forming an HTS layer on top of the buffer layer. The depositing step can be any process designed to form thin films including pulsed laser deposition (PLD), sputtering, physical vapor deposition, metal organic chemical vapor deposition (MOCVD), metal organic deposition (MOD) or mixtures or combinations thereof (para 0019). Metal substrates include Ni/alloys (0035), and the reference specifies Sm- doped (0.01-0.35%) CeO2 (0040; 0053). The reference specifically or inherently meets each of the claimed limitations.

The reference is anticipatory.

In the event that any minor modifications are necessary to meet the claimed limitations, such as selection of particular heating temperature or pressure, such modifications are well within the purview of the skilled artisan.

In view of the foregoing, the above claims have failed to patentably distinguish over the applied art.

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (571) 272-1319. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark Kopec
Primary Examiner
Art Unit 1796

MK
January 31, 2008

/Mark Kopec/
Primary Examiner, Art Unit 1796